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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,492	01/06/2006	Sophie Duquesne	REGIM 3.3-057	2459
530 7590 03/21/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER SANDERS, KRIELLION ANTIONETTE				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/539,492

**Applicant(s)**

DUQUESNE ET AL.

**Examiner**

Kriellion A. Sanders

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date 6/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. Claims 11-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7 and 9-13 of U.S. Patent No. U.S. Patent No.7,105,605. Although the conflicting claims are not identical, they are not patentably distinct from each other because:
2. The present invention relates to a copolymer for use in or as a polymeric binder for an intumescent coating comprising: a blend of a Newtonian copolymer and a reticulated copolymer, wherein said blend of Newtonian copolymer and reticulated copolymers includes at least one substituted styrene and at least one substituted acrylate comprising p-methylstyrene and 2-ethylhexylacrylate.
3. The patented invention is directed to a copolymer composition for use in or as a polymeric binder in an intumescent coating, said copolymer composition comprising a blend of a Newtonian copolymer and of a reticulated copolymer, wherein the Newtonian copolymer is comprised of p-methylstyrene repeat units and 2-ethylhexylacrylate repeat units, and wherein the reticulated copolymer is comprised of p-methylstyrene repeat units and 2-ethylhexylacrylate repeat units.

The Newtonian copolymer may be the same as that of the patented invention, The reticulated copolymer may be the same as that of the patented invention.

4. Claims 11-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent Nos. 7,288,588.
5. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed Newtonian copolymer and intumescent additives may be the same as that of the patented inventions, The reticulated copolymer may be the same as that of the patented invention.
6. Claim 24 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/517,623. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of solvent as dissolution substance is claimed in each application and is therefore an obvious choice.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al US Patent No. 3,733,289 in view of Korper US Patent No. 5,964,931.

At page 5, lines 13 – 23 of applicant's specification applicant states that:

The examples of suitable Newtonian copolymers include Pliolite VTAC-L, Pliolite VTAC-H, Plioway ECH, Plioway Ultra 200, Plioway ECI, all trademarks from 20 ELIOKEM. The examples of suitable reticulated copolymers include Pliolite AC3H, Plioway ECL, Plioway Ultra G20, Plioway EC-T, all trademarks from ELIOKEM.

Burns et al discloses a method of making an intumescent composition that may comprise the vinyl resins of applicant's invention, (such as Pliolite VTAC TM or pliolite VTAC-L TM). The compositions may further include chlorinated paraffin, a carbon forming substance, a foam-forming substance of polyphosphoric acid and an ammonium salt of phosphoric acid. The reference also discloses the inclusion of other conventional additives for intumescent coatings as set forth in the working examples. The components of the patented compositions are mixed together to form the resulting coating compositions. See col. 2, lines 44-57, col. 3, lines 39-73, claims 11, 13 and 17-18.

Korper discloses a method for producing a coating composition that may comprise a primary resin, (such as Plioway Ultra 200 TM), disclosed by applicant as being a suitable Newtonian resin; and a secondary resin, (such as Plioway Ultra G20 TM), which is disclosed by applicant as being a suitable reticulated resin at page 5 of the specification. See Korper at col. 6, lines 45-50, See col. 7, line 2. Therefore, the reference discloses the presently claimed blends. Also see column 6, line 46 et seq. The reference also discloses the inclusion of other conventional additives as well as process steps that correspond to the present claims. See column 7, line 25 to column 8, line 19.

Both references teach the manufacture of a coating composition. Burns et al discloses that the resins employed, are identical to those of applicant's claims and those of the Korper document. Burns et al also teaches that the resulting compositions possess intumescent characteristics. The production steps set out by Korper are conventional. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the resins disclosed by either reference in the manufacture of a coating composition, in the manner taught by the references, following the guidelines set forth therein. Burns would provide guidance for formulating an intumescent composition utilizing the components of the patent. Applicant has shown nothing of an unexpected nature by following the directions of the patented disclosures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kriellion A. Sanders/

Primary Examiner, Art Unit 1796

Kriellion A. Sanders  
Primary Examiner  
Art Unit 1796

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